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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,101	07/08/2003	Ying Luo	RIGL-010CIP3	5361
24353 7590 03/18/2008 BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303				
EXAMINER				
CHOWDHURY, IQBAL HOSSAIN				
ART UNIT		PAPER NUMBER		
1652				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/616,101

Applicant(s)

LUO ET AL.

Examiner

IQBAL H. CHOWDHURY

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-43 and 45-56 is/are pending in the application.
4a) Of the above claim(s) 45-47 and 54-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-43 and 48-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 1/4/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Application Status

Claims 38-43 and 45-56 are currently pending in the instant application.

In response to a previous Office action, a non-final action (mailed on September 7, 2007), Applicants filed a response and amendment received on December 19, 2007, amending claims 38-41, and 45 and adding new claims 48-56 is acknowledged. Claims 45-46 and 47 remain withdrawn, and claims 1-37 and 44 remain cancelled. Claims 54-56 remain withdrawn as they are drawn to non-elected invention.

Claims 38-43 and 48-53 are under consideration and will be examined herein.

Applicants' arguments filed on December 19, 2007, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Maintained-Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Previous rejection of Claims 38-43 under 35 U.S.C. 102(e) as being anticipated by Christenson et al. (US 20030190739A1, effective filing date 6-29-1999), is maintained and claims 49-53 are included in this rejection.

Claims 38-43 and 48-53 of the instant application are drawn to a cell lysate composition comprising a recombinant Tankyrase H protein, a source ADP-ribose or labeled NAD, wherein said enzyme has ADP-ribose polymerase activity, wherein said composition comprises a test agent, such as an organic molecule of less than 2500 Da, a peptide and said polypeptide has an amino acid sequence that is at least 95% identical to SEQ ID NO: 3 or 4, wherein the composition is a cell lysate.

Applicants argue that the Christianson et al. reference was antedated in the immediate parent of this application (09/843,159, which is now US patent) by a declaration of 9/8/2004 and Christianson et al. reference is again antedated by submitting declaration on February 26, 2007 of this application. This is not found persuasive because currently, this case is now examining by a new Examiner, and after careful review, the Examiner finds that declaration 1.131 does not show a conception of SEQ ID NO: 3 and 4 prior to 6/29/1999. The sequences shown prior to the date of the reference are not full-length, and conception of a fragment of a sequence is not conception of the full-length sequence (see *In re Fiers*, 984 F2d at 1171, 25 USPQ2d (BNA) at 1606). Furthermore, diligence is not an issue unless conception is prior to the date the reference.

As discussed previously, Christenson et al. disclose a polypeptide Tankyrase H (99.9% identical to SEQ ID NO: 3 and 4 of the instant application), and functionally a PARP, cell lysate, exogenously added substrate i.e. ADP-ribose (see paragraph [175]) or labeled or unlabeled NAD (see Example 7, and page 35, paragraph [0321]. Christenson et al. also teach a fusion protein (paragraph [0066]). Claims 39 and 40 are included in this rejection because Christenson et al. teach cell lysate, which inherently contains many biologically active peptides within the scope of the claim.

Therefore, the rejection is maintained.

Withdrawn-Claim Rejections - 35 USC § 102

Previous rejection of Claims 38-43 under 35 U.S.C. 102(c) as being anticipated by Christenson et al. (US 20030190739A1, effective filing date 6-29-1999), is withdrawn in view of applicants amendment of claim 38. Indeed, Daly et al. do not teach an exogenously added source of ADP-ribose.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat N. Nashed can be reached on 571-272-0934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Iqbal Chowdhury, PhD, Patent Examiner

Art Unit: 1652

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